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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,001	11/30/2001	Toshiteru Takano	914-146	7244
23117	7590	05/18/2006		
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER ZEENDER, FLORIAN M	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,001

Applicant(s)

TAKANO, TOSHITERU

Examiner

F. Ryan Zeender

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 2 is objected to because of the following informalities: In claim 2, line 3, it appears "said one of the second terminals store" should be --said one of the second terminals stores--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-8, 11-15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foreign Patent Publication No. WO 9735311 (Allen) in view of U.S. Patent No. 5,699,262 (Lang) and Official Notice.

Allen discloses a content program distributing and returning system including a first terminal as clearly set forth in page 12, line 5 through page 13, line 23, page 17, lines 8-28, and page 37, line 4 through page 45, line 24.

Allen fails to disclose the use of a plurality of second terminals that execute a process for disabling reading of the content program stored in prescribed memory and said plurality of second terminals being unable to execute rental of the content program by storing the content program in the prescribed memory. It is noted that Allen disclose

a single terminal (123) for both renting/manufacturing and receiving returns of movie rentals.

Lang disclose a terminal that executes a process for disabling reading of the content program stored in said prescribed memory and said second terminal is unable to execute rental of the content program by storing the content program in the prescribed memory (see Figure 7; column 17, #339, "checked into inventory").

Further, the Examiner takes Official Notice that it was well known at the time of the invention to employ multiple return facilities/terminals for borrowed/rented items spatially separated from each other and spatially separated from a checkout/rental facility/kiosk. This can be seen in for example county public library systems throughout the United States. A person can check out books/videos at the main branch of the library and then return the books/videos at any other branch of the of the library system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Allen with a separate terminal for processing returned rentals, in view of Lang and Official Notice, because incorporating individual return units provide the customer with a greater number of return locations. The combination rent and return unit of Allen includes more features (for example, means for video recording) that are more expensive than a single unit for processing returns. Therefore, a greater number of less expensive return only terminals could be implemented to improve customer service regarding movie rental returns.

Claims 2, 3, 9, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Lang and Official Notice, as applied to claims 1, 5-8, 11-15, and 18-20 above, and further in view of U.S. Patent No. 6,317,722 (Jacobi).

As noted above, Allen in combination with Lang and Official Notice teach all the features of the claimed invention with the exception of the second terminals storing information of recommended content programs to the prescribed memory as set forth in claims 2, 9 and 16 of the instant application.

On the other hand, Jacobi is submitted to teach such a feature. Applicant's attention is invited to the abstract of the disclosure as well as col. 2, line 33 through Col. 4, line 34.

Accordingly, to provide the second terminals of Allen, in combination with Lang and Official Notice, with stored second terminal information of recommended content programs to the prescribed memory, as suggested by Jacobi et al., would have been obvious for one having ordinary skill in the art at the time of the invention. The motivation for such a change would have been to increase the revenue of the merchant as well as aid the shopper in making additional selections.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Lang and Official Notice, as applied to claims 1, 5-8, 11-15, and 18-20 above, and further in view of U.S. Patent No. 6,055,314 (Simon).

Allen, in view of Lang and Official Notice, teach all the features of the claimed invention with the exception of the first terminal storing the content program and a key

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necessary for reading the content program simultaneously in said prescribed memory; and the second terminals executing the process for disabling reading of the content program stored in said prescribed memory by destroying the key.

However, Simon et al. is submitted to teach such a feature; in particular col. 2, line 26 through col. 3, line 51. Accordingly, to provide Allen, in combination with Lang and Official Notice, with the first terminal storing the content program and a key necessary for reading the content program simultaneously in said prescribed memory; and the second terminals executing the process for disabling reading of the content program stored in said prescribed memory by destroying the key, as suggested by Simon et al., would have been obvious for one having ordinary skill in the art at the time of the invention. The motivation for such a change would have been that all long-term keys are easily revocable by the video content provider. This ensures that any successful attack at one specific system component can be contained.

Response to Arguments

Applicant's arguments filed 1/30/2006 have been fully considered but they are moot in view of the new grounds of rejection. However, the Examiner will address relevant arguments.

The applicant argues on page 12 that Allen teaches away from having a plurality of return terminals because Allen teaches that the returns go back to the manufacturing center for re-use. However, with the use of Official Notice above, the Examiner notes that it was well known in the art to have multiple return facilities and therefore it would have been obvious to one of ordinary skill in the art to have users in Allen's system

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return the VHS/DVD to one of a plurality of manufacturing centers. Allen, in no way, teaches away from the well known concept of utilizing a plurality of return facilities. Further, even though Lang teaches returning the VHS/DVD to stock within the store, it does not teach away from the well known concept utilizing a plurality of facilities/terminals for the return.

Therefore, the rejection above is proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (571) 272-6790. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The receptionist's phone number for the Technology center is (571) 272-3600.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

F. Zeender
Primary Examiner, A.U. 3627
May 15, 2006


F. RYAN ZEENDER
PRIMARY EXAMINER